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EXAMINER

SHEDRICK, CHARLES TERRELL

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/664,625	Applicant(s) OWENS ET AL.	
	Examiner Charles Shedrick	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-36 is/are pending in the application.
 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-14, 19-22 and 26-36 is/are rejected.
- 7) ☐ Claim(s) 5-7, 15-18 and 23-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Response to Arguments

2. Applicant's arguments filed 4/17/06 with respect to claims 22 and 26-35 have been fully considered but they are not persuasive.

3. Applicant's arguments with respect to claims 2,8-14, 19-21, and 36 have been considered but are moot in view of the new ground(s) of rejection.

Consider **claims 22 and 26**, Applicant argues Girod does not teach or suggest circuitry that stops frequency scanning when a device is detected. In response to applicant's argument that teach or suggest circuitry that stops frequency scanning when a device is detected, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. **In re Hutchinson, 69 USPQ 138**. Applicant further argues that Girod does not teach or suggest a receiver that receives and detects a response to a transmitted signal to a transmitted pseudo base station signal. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a receiver that receives and detects a response to a transmitted signal to a transmitted pseudo base station signal) are not recited in the rejected

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claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim 22 recites a receiver “for” doing something which does not distinguish over prior art see col. 2 lines 25-29). Applicant further argues that Girod does not teach “sending a pseudo base station signal and looking for a response”. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., sending a pseudo base station signal and looking for a response) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Consider claim 29, In response to applicant's argument that the references fail to show disabling (i.e., to render non functional). Girod teaches rendering the transmitter non functional in terms of transmitting thus disabling (col. 5 lines 46-66).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **2,3,8,9, and 11** rejected under 35 U.S.C. 102(b) as being anticipated by Oura US Patent No.5,991,614.

Consider **claim 2**, Oura, teaches a detector for detecting telephone-activated devices, comprising: a conductive shield 3 having an open end (i.e., a threshold, doorway, entrance, or opening) for placing objects that may contain a telephone-activated device, at least in proximity thereto (see at least col. 2 line 66 – col. 3 line 12); a transmitter 6 for transmitter for generating and transmitting a pseudo base station signal corresponding to a base station signal for a telephone activated device (see at least col. 1 lines 47-56, col. 4 lines 4 – 31); a receiver 7 for receiving and detecting a response signal transmitted by the telephone-activated device (see at least col. 1 lines 47-56, col. 4 lines 28 – 51); wherein the transmitter directs at least part of the pseudo base station signal into the shield (see at least col. 2 line 66 – col. 3 line 12) and wherein at least part of the transmitter is within the shield (i.e., see at least figure 1(b)).

Consider **claim 3**, and **as applied to claim 2**, Oura teaches the claimed detector wherein the at least part of the receiver is within the shield (i.e., see at least figure 1(b)).

Consider **claim 8 and as applied to the detector of claim 2**, Oura teaches the claimed invention further comprising a response unit operatively coupled to the receiver (see at least col. 1 lines 47-56, col. 4 lines 28 – 51); wherein the response unit generates a response based on a result of operation of the receiver (see at least col. 1 lines 47-56, col. 4 lines 28 – 51); and wherein the response unit includes a feedback unit that provides information to an operator regarding the result of the operation of the receiver (see at least col. 1 lines 47-56, col. 4 lines 28 – 51, and col. 3 lines 25-27).

Consider **claim 9**, and **as applied to claim 8**, Oura teaches wherein the response unit also includes an interdiction device that affects operation of the telephone-activated device. (i.e., a control signal is sent) (i.e., see at least col. 6 lines 50-53).

Consider **claim 11 and as applied to the detector of claim 8**, Oura teaches wherein the feedback unit provides a first signal to the operator when the result is that a telephone-activated device is detected, and a second signal to the operator when the result is that a telephone-activated device is not detected (**column 5 line 18 –39**).

Claims **22 and 26-35** are rejected under 35 U.S.C. 102(e) as being anticipated by Girod U.S.

Patent #6,687,506 B1

Consider **claim 22**, Girod clearly discloses a detector (i.e., apparatus with means of detection), comprising:

A transmitter for generating and transmitting a pseudo base station signal (i.e., modified or artificial signal) corresponding to a base station signal to a telephone - activated device (**column 2 lines 4 –14, column 6 lines 19-34**); and

a receiver for receiving and detecting a response signal transmitted by the telephone-activated device (**column 2 lines 25-29**);

wherein the transmitter includes a transmitting antenna and a signal-generating unit that is coupled to the transmitting antenna, adapted to transmit signals (**column 2 lines 63 –67**);

wherein the signal-generating unit (i.e., jammer with transmission signal capabilities) is coupled to a frequency scanner adapted to successively transmit signals, scanning multiple possible base station frequencies (**column 3 lines 5-8**);and

wherein the frequency scanner is coupled to circuitry adapted to stop the scanning when the receiver detects a telephone-activated device (Girod teaches in col. 3 lines 5-8 that the transmission of the jamming signal is performed by scanning the frequency ranges used by the radio telephones. Girod further teaches in col. 5 lines 4-6 that selectivity related to the type of

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subscription or to the type of use (for example, the 112, emergency call in France, must get through) therefore the ability to selectively stop scanning certain telephone activated device is inherent in Girod's invention), while maintaining transmission at the frequency at which the transmitter was transmitting when the receiver detected the telephone-activated device (i.e., a variant that makes it possible to detect the response and jam at intermittent intervals or having the ability to stop and start the process of scanning and jamming)(**column 2 lines 23-29 and column 8 lines 8-11**).

Consider **claim 26**, Girod clearly discloses a method of detecting a telephone - activated device (i.e., other mobile phones or like devices capable of operating at various frequencies) (**column 6 lines 45-49**), the method comprising:

For each of multiple possible base station frequencies, transmitting a pseudo base station signal from a transmitter of a telephone-activated device detector to an object (**column 2 lines 4-14**); checking, with a receiver of the detector, for receipt of signals from the object indicating presence of a telephone-activated device (i.e., comparing data loaded in memory or transmitted by stations)(**column 4 line 24 – 35**); and

If the presence of a telephone activated device is detected, activating an interdiction device of the detector to prevent the telephone-activated device from receiving an incoming call (**column 4 lines 7-16 and column 3 lines 1-15**).

Consider **claim 27** and **as applied to claim 26 above**, Girod clearly discloses a method wherein the interdiction device (i.e., a jammer) includes a jamming device and wherein the activating the interdiction device includes sending a jamming signal from the jamming device to the telephone activated device (**abstract, column 4 lines 7-16**).

Consider **claim 28** and **as applied to claim 26 above**, Girod clearly discloses a method wherein the activating of the interdiction device includes sending a control signal to the telephone-activated device to cause the telephone-activated device to execute an internal function to change its functionality (**col. 2 lines 37-47, column 5 lines 46-66**).

Consider **claim 29** and **as applied to claim 28 above**, Girod clearly discloses a method wherein sending the control signal includes disabling (i.e., jamming) the telephone-activated device (**column 5 lines 46-66**).

Consider **claim 30** and **as applied to claim 26 above**, Girod clearly discloses a method comprising, if a telephone-activated device is detected, activating a feedback unit of the detector to provide an operator of the detector with an indication that the telephone-activated device has been detected (i.e., the hardware unit can respond in transmit or receive mode based on information stored in memory)(**column 4 lines 24-35**).

Consider **claim 31** and **as applied to claim 30 above**, Girod clearly discloses a method wherein the activating includes providing the operator with information extracted from the telephone-activated device (i.e., numbers can be stored in memory of the detection system) (**column 4 lines 24-35 and column 2 lines 37-47**).

Consider **claim 32** and **as applied to claim 31 above**, Girod clearly discloses a method wherein the device includes a telephone number associated with the detected telephone activated-device (**column 2 lines 37-47**).

Consider **claim 33** and **as applied to claim 31 above**, Girod clearly discloses a method wherein the device information includes a registration number associated with the detected telephone activated-device (**column 2 lines 37-47**).

Consider **claim 34** and **as applied to claim 26 above**, Girod clearly discloses a method further comprising, if a telephone activated device is detected, maintaining transmission of the pseudo base station signal (**column 2 lines 4 – 14 and column 8 lines 4-6**).

Consider **claim 35** and **as applied to claim 34 above**, Girod clearly discloses a method wherein the transmission of the pseudo base station signal is maintained until the object is moved to an area where access of incoming telephone signals is blocked, (i.e., jamming restrictions can be applied based on geographic position)(**column 2 lines 4 – 14 and column 4-column 5 lines 14**).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4,10,12-14, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Oura US Patent No. 5,991,614** in view of **Girod U.S. Patent #6,687,506 B1**.

Consider **claim 4**, and **as applied to claim 3**, Oura teaches a transmitter 6 and receiver 7 at least partially within the shield.

However, Oura does not specifically teach a transmitting and receiving antenna.

In the same field of endeavor, Girod teaches a transmitting and receiving antenna (col. 4 lines 24 –36).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a transmitting and receiving antenna for the purpose of controlling transmission and reception as taught by Girod.

Consider **claim 10**, and **as applied to claim 9**, Oura teaches the claimed invention except wherein the interdiction device includes a jamming device for preventing the telephone-activated device from being activated.

However, in the same field of endeavor, Girod teaches a jamming device for preventing the telephone-activated device from being activated (**abstract, column 4 lines 7-16**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oura to include a jamming device for preventing the telephone-activated device from being activated as taught by Girod.

Consider **claim 12 and as applied to the detector of claim 11**, Oura teaches the claimed invention except wherein the receiver extracts device information associated from a particular telephone-activated device that is detected; and wherein the first signal includes the device information.

However, in the same field of endeavor, Girod teaches wherein the receiver extracts device information associated from a particular telephone-activated device that is detected; and wherein the first signal includes device information (i.e., device information can be stored in memory for later use)(**column 4 lines 24-35 and column 2 lines 37-47**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oura to include wherein the receiver extracts device information associated from a particular telephone-activated device that is detected; and wherein the first signal includes device information so that device information can be stored in memory for later use as taught by Girod

Consider **claim 13 and as applied to the detector of claim 12**, Oura teaches the claimed invention except wherein the device information includes a telephone number associated with the particular telephone-activated device.

However, in the same field of endeavor, Girod teaches disclose a detector wherein device information includes a telephone number associated with the particular telephone –activated device (i.e., device information can be stored in memory for later use)(**column 4 lines 24-35 and column 2 lines 37-47**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oura to include wherein the receiver extracts device

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information associated from a particular telephone-activated device that is detected; and wherein the first signal includes device information so that device information can be stored in memory for later use as taught by Girod

Consider claim 14 and as applied to the detector of claim 12, Oura teaches the claimed invention except wherein the device information includes a registration number associated with the particular telephone-activated device.

However, in the same field of endeavor, Girod teaches wherein device information includes a registration number associated with the particular telephone –activated device (i.e., device information can be stored in memory for later use)(**column 4 lines 24-35 and column 2 lines 37-47**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oura to include wherein the receiver extracts device information associated from a particular telephone-activated device that is detected; and wherein the first signal includes device information so that device information can be stored in memory for later use as taught by Girod

Consider claim 19 and as applied to claim 2, Oura teaches a transmitter 6 (figure 1b) and a signal generating unit (i.e., inherent).

However, Oura does not specifically teach a transmitting antenna that is coupled.

In the same field of endeavor, Girod teaches wherein the transmitter includes a transmitting antenna and a signal-generating unit that is coupled to the transmitting antenna (**column 2 lines 63 –67**); and a signal-generating unit that is coupled to the transmitting antenna

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(i.e., a jammer with signal transmitting capabilities via a transmitting antenna)(**column 6 line 38-44 and column 4 lines 24-35**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oura to include a transmitting antenna that is coupled for the purpose of signal transmission as taught by Girod.

Consider **claim 20 and as applied to the detector of claim 19**, Oura teaches the claimed invention except wherein the signal-generating unit is coupled to a frequency scanner adapted to successively transmit signals, scanning multiple possible base station frequencies.

In the same field of endeavor, Girod teaches wherein the signal-generating unit (i.e., jammer with transmission signal capabilities) is coupled to a frequency scanner adapted to successively transmit signals, scanning multiple possible base station frequencies (**column 3 lines 5-8**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oura to include wherein the signal-generating unit (i.e., jammer with transmission signal capabilities) is coupled to a frequency scanner adapted to successively transmit signals, scanning multiple possible base station frequencies for the purpose of jamming.

Consider **claim 21 and as applied to the detector of claim 20**, Oura teaches the claimed invention except wherein the frequency scanner is coupled to circuitry adapted to stop the scanning when the receiver detects a telephone-activated device, while maintaining transmission at the frequency at which the transmitter was transmitting when the receiver detected the telephone-activated device.

However, in the same field of endeavor, Girod teaches wherein the frequency scanner is coupled to circuitry adapted to stop the scanning when the receiver detects a telephone-activated device, while maintaining transmission at the frequency at which the transmitter was transmitting when the receiver detected the telephone-activated device (i.e., a variant that makes it possible to detect the response and jam at intermittent intervals or having the ability to stop and start the process of scanning and jamming)(**column 2 lines 23-29 and column 8 lines 8-11**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oura to include wherein the frequency scanner is coupled to circuitry adapted to stop the scanning when the receiver detects a telephone-activated device, while maintaining transmission at the frequency at which the transmitter was transmitting when the receiver detected the telephone-activated device to provide a variant that makes it possible to detect the response and jam at intermittent intervals or having the ability to stop and start the process of scanning and jamming as taught by Girod.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Girod U.S. Patent #6,687,506 B1** in view of **Oura US Patent No. 5,991,614**.

Consider claim 36 and as applied to the method of claim 28, Girod teaches the claimed invention except wherein disabling the telephone includes causing the telephone-activated device to shut itself off.

However, in the same field of endeavor, Oura teaches wherein disabling the telephone includes causing the telephone-activated device to shut itself off (**col. 4 line 67 and col. 5 lines 10-15**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Girod to include wherein disabling the telephone includes causing the telephone-activated device to shut itself off for the purpose of disabling as taught by Oura.

Allowable Subject Matter

Claims 5-7, 15-18, and 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Shedrick whose telephone number is (571)-272-8621. The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kincaid Lester can be reached on (571)-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charles Shedrick
AU 2617
June 26, 2006


NICK CORSARO
PRIMARY EXAMINER

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